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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/001,039 12/30/97 JOLLY

D 1155.005

EXAMINER

HM12/0324

NORMAN J KRUSE  
CHIRON CORP  
INTELLECTUAL PROPERTY R440  
P O BOX 8097  
EMERYVILLE CA 94662-8097

SCHWARTZMAN, R

ART UNIT

PAPER NUMBER

8

1636

DATE MAILED:

03/24/99

**Please find below and/or attached an Office communication concerning this application or  
proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/001,039

Applicant(s)  
Jolly et al.

Examiner  
Robert Schwartzman

Group Art Unit  
1636



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-90 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-90 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1636

## **DETAILED ACTION**

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, 37-58 and 61-68, drawn to a retrovirus vector, classified in class 435, subclass 320.1.
- II. Claims 12-36, 59, 60 and 69-84, drawn to a pharmaceutical composition comprising a retrovirus vector and a method of administering a retrovirus vector to a patient, classified in class 514, subclass 44.
- III. Claims 85 and 86, drawn to a method of increasing the efficiency of infecting a mammalian cell with a retrovirus, classified in class 435, subclass 325.
- IV. Claims 87-90, drawn to a method of administering a gene delivery vehicle to a patient suffering from arthritis, classified in class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

Art Unit: 1636

The retrovirus of Group I is distinct from the methods of Groups II, III and IV as it can be used in any of the claimed methods and therefore has multiple distinct uses. Furthermore, each method could be carried out using a different vector from the retrovirus of Group I.

The methods of Groups II, III and IV are distinct as they each have different starting materials, different steps, different results and different uses.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Paul B. Saveriede on March 17, 1999 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

Art Unit: 1636

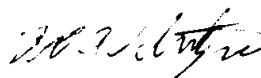
named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Schwartzman whose telephone number is (703) 308-7307. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, can be reached at (703) 308-4003. The fax number for this group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)-308-0196.

Robert A. Schwartzman, Ph.D.  
March 23, 1999

  
ROBERT A. SCHWARTZMAN  
PATENT EXAMINER